

REMARKS/ARGUMENTS

The claims are 2-6 and 13, with claims 7-12 having been withdrawn from consideration by the Examiner as directed to a non-elected invention. Claim 1 has been canceled in favor of new claim 13 and accordingly, claims 2 and 5, which previously depended on claim 1, have been amended to depend on new claim 13. These claims and claims 3, 4 and 6 have also been amended in view of new claim 13, which is directed to an assembly or to otherwise improve their form. Support may be found, *inter alia*, in the disclosure at pages 6-7. Reconsideration is expressly requested.

Applicant hereby affirms the previously-made provisional election, with traverse, of Group I, claims 1-6, drawn to a device. It is believed that any search for the device of the claims of Group I, would necessarily include a search for the method embodied in the remaining Group II. Thus, the simultaneous search for both Groups I and II is believed not to constitute an unreasonable search for the Patent Examiner.

In addition, it is believed that the objectives of streamlined examination and compact prosecution would be promoted if a search were conducted simultaneously for both groups. Also, the necessity

of filing multiple patent applications in this case does not serve to promote the public interest because of the extra expense that is involved, in filing fees and examination costs, as well as the burden upon the public, due to the necessity of searching through a multiplicity of patent files in order to find the complete range of the subject matter claimed in several different patents that could otherwise be found in one issued patent only.

Applicant reserves the right to file a divisional application for the non-elected method claims of Group II.

For all these reasons, it is respectfully requested that the restriction requirement under 35 U.S.C. 121 be withdrawn and that method claims 7-12 be rejoined for examination.

Claims 1 and 2 were provisionally-rejected on the grounds of non-statutory obviousness type double-patenting as being unpatentable over claims 3 and 9 of co-pending *U.S. Patent Application Serial No. 10/590,951*. In response, Applicant submits herewith a Terminal Disclaimer disclaiming the terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the

full statutory term of any patent granted on co-pending U.S. Patent Application Serial No. 10/590,951. The required Terminal Disclaimer fee under 37 C.F.R. 1.20(d) is submitted as well. It is respectfully submitted that the enclosed Terminal Disclaimer overcomes the Examiner's provisional rejection based on non-statutory obviousness type double-patenting over Applicant's co-pending U.S. Patent Application Serial No. 10/590,951, and Applicant respectfully requests that the provisional double-patenting rejection be withdrawn.

Claim 1 was objected to as being indefinite as failing to specify whether the two floor surfaces were claimed with the bridging device. Claims 1 and 4 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons set forth on page 4 of the Office Action. In response, Applicant has canceled claim 1 in favor of new claim 13 directed to an assembly which affirmatively recites the elements of a first floor surface or second floor surface and the additional elements previously recited in claim 1. Corresponding amendments have also been made to dependent claims 2-6, and claims 2 and 5 have been further amended to depend on new claim 13. It is respectfully submitted that the foregoing amendments overcome the Examiner's rejection

under 35 U.S.C. § 112, second paragraph, and the objection to claim 1 as being indefinite, and Applicant respectfully requests that the rejection and objection on these bases be withdrawn.

Claims 1-4 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Biela U.S. Patent No. 3,667,177*. The remaining claims 5-6 under consideration by the Examiner were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Biela*. Essentially the Examiner's position was (1) that *Biela* discloses the claimed bridging device, except for the covering flange abutting or contacting the compensating strip as recited in claims 5 and 6, (2) that one of ordinary skill in the art is able to change a shape of a device absent persuasive evidence to the contrary, and (3) that it would have been obvious to one of ordinary skill in the art to change the shape of the end piece of the bridging device of *Biela* to have an extension that abuts or contacts the compensating strip as recited in Applicant's claims 5 and 6 which would aid in sealing off any moisture.

This rejection is respectfully traversed.

As set forth in new claim 13, Applicant's invention provides an assembly including a first floor surface having a first height, a second floor surface having a second height less than the first height, a profiled cover including a covering flange and a clamping extension, a fixture including a clamping seat, and a compensating strip. The covering flange extends above the first and second floor surfaces. The clamping extension protrudes downwards from the covering flange, extends longitudinally with respect to the profiled cover, and engages with the fixture by clamping.

As recited in new claim 13, the compensating strip sits between the covering flange of the profiled cover and the second floor surface so that the covering flange is supported via the compensating strip on the second floor surface, and the compensating strip is clamped into the clamping seat of the fixture.

In this way, Applicant's invention provides an assembly in which a difference in height between two floor surfaces is bridged, fulfills the requirements for the exact fit of a profile cover and compensating strip, and is simple to manufacture.

Thus, with Applicant's assembly, the compensating strip 10 compensates for the height difference between the two floor surfaces 1, 3, whereby this compensating strip 10 lies between the covering flange 5 of the profiled cover 4 and the lower one of the two floor surfaces 1, 3 so that the covering flange 5 is supported via the compensating strip 10 on the lower floor surface 3.

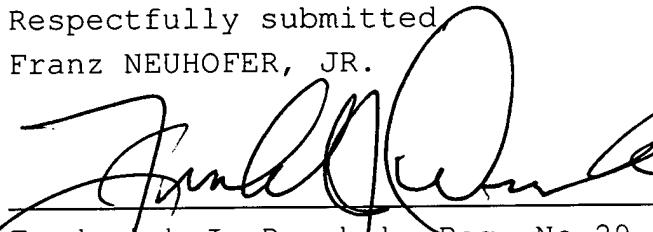
In contrast, according to *Biela*, the retainer 32 in FIG. 10 is fastened on a wall 92 and is sealed opposite this wall 92 in a water-tight manner, i.e. with an adhesive seal 96, as described in column 4, lines 54-59 of *Biela* (the reference numeral "96," however, is missing from this passage). The adhesive seal 96 of *Biela*, therefore, does not form a compensating strip as recited in Applicant's new claim 13 because the covering flange 48 of the covering profile 88 of *Biela* is not supported via the sealing 96 on the wall 92, but rather directly via a bead portion 52. Because in addition, the seal 96 of *Biela* is not connected with the retainer with the help of a clamp fit, it is respectfully submitted that *Biela* cannot anticipate or render obvious Applicant's assembly as recited in new claim 13.

Accordingly, it is respectfully submitted that new claim 13, together with claims 2-6 which depend directly or indirectly thereon, are patentable over Biela.

In summary, claim 1 has been canceled, claims 2-6 have been amended and new claim 13 has been added. A Terminal Disclaimer and the required fee are also submitted herewith. In view of the foregoing, it is respectfully requested that the claims be allowed and that this application be passed to issue.

Applicant also submits herewith a Supplemental Information Disclosure Statement.

Respectfully submitted
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Enclosures:

Supplemental Information Disclosure Statement with Form PTO-1449
Check in the amount of \$180.00
Executed Terminal Disclaimer with check in the amount of \$70.00

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 20, 2010.



Amy Klein